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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/189,615	11/09/1998	NIELS GEBAUER	33012/246	5678

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EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/189,615

Applicant(s)

GEBAUER, NIELS

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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#### DETAILED ACTION

1. Claims 1-22 are pending in the present application.
2. **Cook and Dawson et al.** was cited as prior art in the last office action paper number sixteen; the rejection is respectfully maintained.
3. The declaration filed on January 17, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Dawson et al. reference.

An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situation: Where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case, that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131. *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973). Note MPEP 715

Note paper number five in which COOL ICE User's Guide Release 1.1 was cited; Applicant has admitted in the declaration that claims 1-22 are embodied in this reference which has a publication date March 1997.

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 15, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 15, and 19 contains the trademark/trade name CLASSIC MAPPER. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a software product and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-14, 16-18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook US Patent 5,621,892 in view of Dawson et al. US Patent 6,347,330 B1 .

With respect to claim 1, **Cook** teaches in a data processing environment having a user terminal which generates a service request coupled to a publicly accessible digital communications network and having a data base management system which receives and responds to said service request when available, the improvement comprising:

a server coupled to said terminal via said publicly accessible digital communications network and coupled to said data base management system wherein said server includes an administration management system which transfers an unavailability message to said user terminal in response to said service request when said data base management system is unavailable to receive and respond to said service request [see: abstract; figure 2 and figure 4; col. 3 line 58 through col. 4 line 9; col. 5 lines 3-14].

Although Cook teaches the invention substantially as cited above, he does not specifically disclose that the alert is an unavailability message. **Dawson et al.** teaches an alert message that

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lets the user know the system is not available [abstract; figure 1; col. 4 lines 25-58; col. 5 lines 1-52].

It would have been obvious to one of ordinary skill at the time of the invention to have combined Cook with Dawson et al because Dawson et al would let the user know that the specific alert type such as the system is unavailable because of insufficient memory.

8. With respect to claims 2-4:

(Claim 2) wherein said state manager includes a repository for storing said unavailability message [Cook note event manager (214) figure 2; col. 4 lines 50-66].

(Claim 3) wherein said publicly accessible digital communications network is the world wide web [Cook note service providers (240) col. 4 lines 2-9]

(Claim 4) wherein said repository includes space for storage of at least one variable for said availability message [Cook (622) figure 6].

9. With respect to claim 6:

- a. a user terminal which generates a service request [Cook figure 2 (212, 220)];
- b. a publicly accessible digital communications network coupled to said user terminal [Cook network (210) figure 2]; and
- c. a server coupled to said publicly accessible digital communications network [Cook (214) figure 2];

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d. a data base management system responsively coupled to said server which responds to said service request if available [Cook (228) figure 2]; and

e. an administration management system responsively coupled to said data base management system and said server which transfers an unavailability message from said server to said user terminal in response to said service request when said data base management system is not available to indicate unavailability of said data base management system [note: Cook, event management (222) figure 2; col. 3 line 58 through col. 4 line 9; col. 5 lines 3-14].

10. With respect to claims 7-10:

(Claim 7) wherein said data base management system has a repository having storage for said unavailability message [Cook note event manager (214) figure 2; col. 4 lines 50-66].

(Claim 8) wherein said repository has storage for a variable to be included in said unavailability message [Cook (622) figure 6].

(Claim 9) wherein said publicly accessible digital communications network is the world wide web [Cook note service providers (240) col. 4 lines 2-9]

(Claim 10) wherein said user terminal is an industry compatible personal computer having a commercially available web browser [Cook inherent].

11. With respect to claim 11:

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transmitting a service request ... determining whether said data base management system is currently capable of honoring said service request ... honoring said service request ... transferring an unavailability message to said terminal if said determining step determines that said data base management system is not currently capable of honoring said service request [Cook col. 7 lines 6-9; col. 7 line 46 through col. 8 line 10]

12. With respect to claims 12-14:

wherein said transferring step further comprises transferring said availability message ... [Cook figure 4 (418); col. 4 lines 50-53].

13. With respect to claim 16:

means for permitting a user to interact with a digital data base by generating a service request in anticipation of a response ... [Cook col. 4 lines 40-49].

14. The limitations of claim 17, 18 and 20-22 have been addressed above therefore; they are rejected under the same rationale.



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***Response to Arguments***

15. The declaration under 37 CFR 1.131 filed January 17, 2003 is insufficient to overcome the rejection of claims 1-22 based upon Dawson as set forth in the last Office action note reason above in paragraph three.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Hernandez** US Patent 5,949,977

**Garcia Jr. et al.** US Patent 6,470,357 B1

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta Robinson whose telephone number is (703)308-7565. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached at (703)305-9790.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

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(703)746-7239, (for formal communications)

**Or:**

(703)746-5657, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-9600.



**GRETA ROBINSON**  
**PRIMARY EXAMINER**

Greta Robinson

Primary Examiner

February 20, 2003